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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/547,395	04/11/2000	Mark Wang	UCSD99-037	4506

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04/22/2002

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EXAMINER

HAMILTON, CYNTHIA

ART UNIT

PAPER NUMBER

1752

DATE MAILED: 04/22/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant No.

09/547,395

Applicant(s)

WANG ET AL.

Examiner

Cynthia Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-24 is/are rejected.
- 7) ☒ Claim(s) 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

1. Applicant's election without traverse of Group III in Paper No. 3 is acknowledged.
2. Applicants have cancelled claims 1-9, and 25-33. Claims 10-24 remain.
3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 10 is objected to because of the following informalities: In line 10, "Can" should be "can"; fourth line from the end of claim 10, "ares" should be "areas". Appropriate correction is required.

6. Claims 14-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 14, 16 and 19 recite the limitation "photopolymer" in the fifth, first and second line, respectively. There is insufficient antecedent basis for this limitation in the claim.

There is no photopolymer found in claim 10 to be referenced later. Further, what is meant by the term "photopolymer" is unclear because of the defining of it in claim 16 without the essential polymer being present in one of the essential components present. A monomer is not usually considered a polymer or a photopolymer. It may be the precursor to a polymer however.

Further, if the monomer is to become the photopolymer then is the photopolymer still

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photoactivable as is the art recognized meaning of photopolymer. Thus, photopolymer as used in claims 14-19 is confusing. The examiner is unclear what is intended by this term.

7. Claims 10-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. The language in claim 10 leaves unclear whether applicant is claiming the unwritten medium or the written medium because of the wording "suitably selectively written by radiation at a writing time. Has the time of writing occurred? Is it a future step? The use of "having been selectively written by radiation a writing time" instead here will make clear that the written medium is claimed and not the unwritten medium. Applicant makes reference to this "writing time" later in the claim. The reference is in the present tense again adding confusion what is being claimed. Is the written medium claimed or the unwritten medium? Thus, claims 10-24 are indefinite. The examiner notes that applicants have elected the recorded medium for examination by election of Group III as originally presented.

b. The definition of medium seems to be drawn to the before writing medium in that it consists of the monomer and dye in a matrix which is described as moving and forming a polymer upon photoexcitation. Thus, the wording "the medium consisting essentially of " is confusing if the medium is written on. Wording to avoid this problem could be "the medium before writing consisting essentially of ".

c. In lines 14-18 of claim 10, there appear to be two limits of varying scope for the same action. The wording in question is "both (i) polymerization of the monomer into

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the polymer and (ii) fixing the dye to the polymer will occur in these selected areas, that is, the monomer undergoes a polymerization process that solidifies the matrix, while, simultaneously, molecules of radiation-exposed and photoexcited dye bind to at least molecules of polymer". It is unclear whether starting with "that is, the monomer undergoes a polymerization process that solidifies the matrix, while, simultaneously, molecules of radiation-exposed and photoexcited dye bind to at least molecules of polymer" a narrower limit is being described or a definition of (i) and (ii) is being set forth or a further limit to (i) and (ii) is being set forth. The variance of limit in an optional manner is indefinite leaving unclear which limit is being claimed.

8. Applicant's arguments filed January 17, 2002 have been fully considered but they are not persuasive. Applicants argue that by amendment they have answered all of the examiner's rejections which they characterize as clearing up the "status/state of the claimed physical elements". Applicants have failed to clarify if the medium is imaged or unimaged as claimed. Thus, the rejection has been repeated. Other issues of clarity are present due to the amended claim language.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Hamilton whose telephone number is (703) 308-3626. The examiner can normally be reached on Monday-Friday, 9:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Baxter can be reached on (703) 308-2303. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305 0661.

C. Hamilton
April 19, 2002



**CYNTHIA HAMILTON
PRIMARY EXAMINER**